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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,139	10/12/2001	Udo Retzlaff	1698A1	2405
7590		03/08/2004	EXAMINER	
PPG INDUSTRIES, INC.		MAYEKAR, KISHOR		
One PPG Place		ART UNIT		
Pittsburgh, PA 15272		PAPER NUMBER		
		1753		

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,139	Applicant(s) RETZLAFF ET AL. 	
	Examiner Kishor Mayekar	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
 4a) Of the above claim(s) 32-37 and 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 38-40 and 45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/22/03 & 10/20/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-31, 38-40 and 45, drawn to an electrocoat composition and a method for electrocoating a conductive substrate, classified in class 204, subclass 471+.

II. Claims 32-37 and 41-44, drawn to a method for reducing the gloss of a coating deposited on a substrate and an electrocoat composition, classified in class 428, subclass 416+.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different

process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a non-electrocoating process.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney D. Meyers on 2/19/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-31, 38-40 and 45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-37 and 41-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the phrase "10 microns, +/- 5 microns" is confusing and cannot be understood.

In claim 8, the phrase "the total weight" is lacking antecedent basis.

Claim Rejections - 35 USC § 102 and § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 4, 9 and 25-27 are rejected under 35 U.S.C. 102(b) as being being clearly anticipated by FREESE et al. (4,536,525). The reference's invention is directed to an aqueous coating composition based on a cationic amino urea resin. The reference discloses the coating composition may contain particulate polymers such as powdered polyacrylate (col. 8, lines 30-37).

11. Claims 5-8, 14-17 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over FREESE '525. The differences between the reference and the instant claims are each of the limitation recited in the instant claims. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the references teachings because the selection of particle size, weight percent and density of the solid particulate would have been within the level of ordinary skill in the art.

12. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2074578 A in view of either SAVIN (5,792,803) or HOUSEL et al. (5,880,250). The reference's invention is directed to a cathodic electro-deposition coating composition. The reference discloses that the coating composition contains fusible solid thermo-setting resin powder which is of the type used in powder coatings including epoxy resins, polyesters and polyurethanes. SAVIN shows the use of powder coating contains the above resins and polymers of acrylic. HOUSEL shows the family of polyurethanes including the traditional polyurethane polymers and polyurethane-polyurea copolymers (col. 10, lines 46-57). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time

the invention was made to have modified the reference's teachings as shown by SAVIN '803 or HOUSEL '250 because the selection of any of known equivalents powder compositions would have been within the level of ordinary skill in the art. The same is applied to the subject matter of claim 10 to the use of sulfonium acrylic resin as the cationic electrodepositable resin.

As to the subject matter of claims 11-13 and 18-24, the sequence of adding ingredients to the electrocoating composition would also have been within the level of ordinary skill in the art.

As to the subject matter of each of claims 5-8, 14-17 and 28-31, the selection of particle size, weight percent and density of the solid particulate would have been within the level of ordinary skill in the art.

13. Claims 1, 3-19, 21-31, 38, 40 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSUCHIYA et al. (4,975,475), a reference cited by Applicant. The reference's invention is directed to an electrodeposition coating composition containing an electrodepositable resin and polymer microparticles. The reference discloses that the electrodepositable resin can be cathodic or anodic 9col. 3, lines 6-7), the polymer microparticles are acrylic polymers (col. 23-

Art Unit: 1753

37). The difference between the reference and the above claims is whether the reference's microparticles are solid particulate. Because the reference discloses in col. 2, line s26-35 that "the polymer particles have a solubility parameter which does not differ by more than 1.0 from the solubility parameter of the water-soluble, electrically depositable resin" and in col. 5, lines 59 through col. 6, line 2, the sieving of the microparticles, the reference's process appears to lead one of ordinary skill in the art that the polymer microparticles are solid particulate.

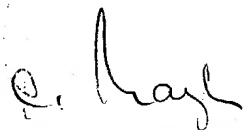
As to the subject matter of claims 11-13 and 18-20, 21-24, the sequence of adding ingredients to the electrocoating composition would also have been within the level of ordinary skill in the art.

As to the subject matter of each of claims 5-8, 10, 14-17 and 28-31, the selection of particle size, weight percent and density of the solid particulate and type of resins would have been within the level of ordinary skill in the art.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kishor Mayekar
Primary Examiner
Art Unit 1753